

U.S. Application No.: 10/635,486  
Response to Office Action of March 20, 2007

Attorney Docket No.: FSF-031421

## REMARKS

Claims 3 and 4 have been cancelled, claim 22 has been added and claim 21 has been amended. Support for the amendment can be found on, for example, pages 13 and 101 to 103.

### **I. Response to Claim Rejection under 35 U.S.C. §103**

#### **A. Rejection over Toya et al. (US Patent No. 5,998,127)**

Claim 21 has been rejected over Toya et al. Independent claim 21 has been amended. Toya et al. fails to teach the feature, "the non-photosensitive organic silver halide includes a needle crystal having a shorter axis of 0.01  $\mu\text{m}$  to 0.15  $\mu\text{m}$  and a longer axis of 0.10  $\mu\text{m}$  to 4.0  $\mu\text{m}$ , and the needle crystal has a monodispersed size distribution in which a standard deviation of a length of the minor axis or major axis divided by a length of the minor axis or major axis, respectively, is not more than 50 %". Moreover, working examples described in Toya et al. teach none of the grain size of the silver halide, the coating amount of the silver halide per 1 mol of the organic silver salt and the silver iodide content recited in amended claim 21 of the present application. As demonstrated in the enclosed Declaration, these features create unexpected improvement in the balance of fogging, sensitivity and Dmax, and suppression of print-out. Therefore, Toya et al. neither teaches nor suggests the presently claimed invention, and the Applicant believes the rejection has been overcome.

**B. Rejection over Kawahara et al. (US Patent No. 6,436,626)  
in view of Toya et al. (US Patent No. 5,998,127)**

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Claims 2 to 6 and 19 to 21 have been rejected over the combination of Kawahara et al. and Toya et al. Independent claim 21 has been amended. Kawahara et al. fails to teach the feature "the non-photosensitive organic silver halide includes a needle crystal having a shorter axis of 0.01  $\mu\text{m}$  to 0.15  $\mu\text{m}$  and a longer axis of 0.10  $\mu\text{m}$  to 4.0  $\mu\text{m}$ , and the needle crystal has a monodispersed size distribution in which a standard deviation of a length of the minor axis or major axis divided by a length of the minor axis or major axis, respectively, is not more than 50 %". Further, the enclosed Declaration clarifies that the features added to claim 21, such as the grain size of the silver halide, the coating amount of the silver halide per 1 mol of the organic silver salt and the silver iodide content, create unexpected improvements in the balance of fogging, sensitivity and Dmax, and suppression of print-out. Toya et al. does not cure the deficiency, as discussed above. Moreover, the silver behenate content is defined in amended claim 21, and the scope of the claim is in commensurate with the results shown in the Declaration submitted on July 21, 2006. Therefore, the combination of Kawahara et al. and Toya et al. neither teaches nor suggests the presently claimed invention, and the Applicant believes the rejection has been overcome.

**C. Rejection over Kawahara et al. (US Patent No. 6,436,626) in view of Uytterhoeven et al. (US Patent No. 6,143,488), Siga et al. (US Patent No. 4,332,889), Ohzeki et al. (US 2003/0194659), Fukui et al. (US 2003/0207216) or Yoshioka (US 2003/0235794).**

Claims 19 and 20 have been rejected over the combination of Kawahara et al. and either Uytterhoeven et al., Siga et al., Ohzeki et al.,

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Fukui et al. or Yoshioka et al. On p. 3 of the Office Action, the Examiner has relied on the teachings of Toya et al. with respect to the coating amount of the silver halide per 1 mole of the organic silver salt. However, in this rejection, the Examiner has not cited Toya et al. and has not explained what reference is used for the teaching of the coating amount of the silver halide whereas citing the rejection of claims 21, 2-6 and 19-20 described p. 3 of the Office Action. Therefore, the Applicant considers that, in the absence of Toya et al., the combination of the cited references mentioned in the rejection of claims 19 and 20 does not make the presently claimed invention *prima facie* obvious. Even if Toya et al. is included, the combination of Kawahara et al. and Toya et al. fails to teach or suggest the presently claimed invention, as described in item B, and the other cited references do not cure the deficiency. Therefore, the combination of the cited references neither teaches nor suggests the presently claimed invention, and the Applicant believes that the rejection has been overcome.

**D. Rejection over Kawahara et al. (US Patent No. 6,436,626) in view of Ikienoue et al. (US Patent No. 4,152,160) or Tsuzuki (US Patent No. 5,677,121).**

Claims 3 to 6 have been rejected over the combination of Kawahara et al. and Ikienoue et al. or Tsuzuki. On p. 3 of the Office Action, the Examiner has relied on the teachings of Toya et al. with respect to the coating amount of the silver halide per 1 mole of the organic silver salt. However, in this rejection, the Examiner has not cited Toya et al. and has not explained what reference is used for the teaching of the coating amount of the silver

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halide whereas citing the rejection of claims 21, 2-6 and 19-20 described p. 3 of the Office Action. Therefore, the Applicant considers that, in the absence of Toya et al., the combination of the cited references mentioned in the rejection of claims 3 to 6 does not make the presently claimed invention *prima facie* obvious. Even if Toya et al. is included, the combination of Kawahara et al. and Toya et al. fails to teach or suggest the presently claimed invention, as described in item B, and the other cited references do not cure the deficiency. Therefore, the combination of the cited references neither teaches nor suggests the presently claimed invention, and the Applicant believes that the rejection has been overcome.

**E. Rejection over Kawahara et al. (US Patent No. 6,436,626) in view of Arai et al. (US Patent No. 6,090,538).**

Claims 10 to 11 and 13 to 17 have been rejected over the combination of Kawahara et al. and Arai et al. On p. 3 of the Office Action, the Examiner has relied on the teachings of Toya et al. with respect to the coating amount of the silver halide per 1 mole of the organic silver salt. However, in this rejection, the Examiner has not cited Toya et al. and has not explained what reference is used for the teaching of the coating amount of the silver halide whereas citing the rejection of claims 21, 2-6 and 19-20 described p. 3 of the Office Action. Therefore, the Applicant considers that, in the absence of Toya et al., the combination of the cited references mentioned in the rejection of claims 10 to 11 and 13 to 17 does not make the presently claimed invention *prima facie* obvious. Even if Toya et al. is included, the combination of Kawahara et al. and Toya et al. fails to teach or suggest the

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presently claimed invention, as described in item B, and the other cited reference does not cure the deficiency. Therefore, the combination of the cited references neither teaches nor suggests the presently claimed invention, and the Applicant believes that the rejection has been overcome.

**F. Rejection over Kawahara et al. (US Patent No. 6,436,626) in view of Goto et al. (US Patent No. 6,787,298) or Farid et al. (US Patent No. 5,747,235).**

Claims 8 and 9 have been rejected over the combination of Kawahara et al. and Goto et al. or Farid et al. On p. 3 of the Office Action, the Examiner has relied on the teachings of Toya et al. with respect to the coating amount of the silver halide per 1 mole of the organic silver salt. However, in this rejection, the Examiner has not cited Toya et al. and has not explained what reference is used for the teaching of the coating amount of the silver halide whereas citing the rejection of claims 21, 2-6 and 19-20 described p. 3 of the Office Action. Therefore, the Applicant considers that, in the absence of Toya et al., the combination of the cited references mentioned in the rejection of claims 8 and 9 does not make the presently claimed invention *prima facie* obvious. Even if Toya et al. is included, the combination of Kawahara et al. and Toya et al. fails to teach or suggest the presently claimed invention, as described in item B, and the other cited references do not cure the deficiency. Therefore, the combination of the cited references neither teaches nor suggests the presently claimed invention, and the Applicant believes that the rejection has been overcome.

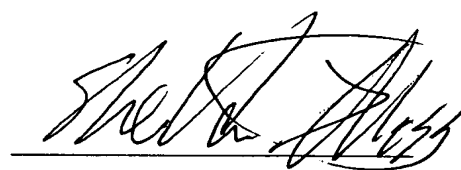
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## **II. Conclusion**

In view of the foregoing amendments and remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Sheldon J. Moss', written over a horizontal line.

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